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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Elizabeth Marie Cameron Alfstad

Serial No. 75/414,711

Edward H. Rosenthal of Frankfurt Garbus Kurnit Klein & Selz, P.C. for Elizabeth Marie Cameron Alfstad.

Rebecca Gilbert, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Seeherman, Bucher and Drost, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Elizabeth Marie Cameron Alfstad, a United States citizen and resident of East Hampton, New York, seeks registration on the Principal Register of the mark BETSY CAMERON for "furniture, namely beds, pillows, chairs, couches, ottomans, dressers, chests, desks, stools, mirrors, tables, armoires, wardrobes, settees and vanity tables," in International Class 20.¹

¹ Application Serial No. 75/414,711 was filed on January 7, 1998, based upon a claim of use in commerce since at least as early as October 1994.

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the typewritten mark BETSY CAMERON'S STORYBOOK for "furniture," also in International Class 20, as to be likely to cause confusion or to cause mistake or to deceive.²

Applicant and the Trademark Examining Attorney have fully briefed the case,³ but applicant did not request an oral hearing.

Turning to the issue of likelihood of confusion, our determination is based upon an analysis of all of the probative facts in evidence that are relevant to the factors set forth in the oft-cited case of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See

² Reg. No. 2,273,493, issued to Lexington Furniture Industries, Inc., of Lexington, NC, on August 31, 1999. The registration explains that "BETSY CAMERON is a living individual whose consent is of record."

³ In her appeal brief, applicant cites to her ownership of the trademark registration for BETSY CAMERON'S CHILDREN, Reg. No. 2,074,934, for children's stationery and art items in International Class 16. However, this registration was not properly made of record. Moreover, even if correctly made of record, the existence of this registration would not change our final determination herein under Sec. 2(d) of the Act.

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

There is no dispute that applicant's pillows are related to registrant's furniture, and that the remaining items of applicant's furniture listed in the identification of goods (e.g., beds, chairs, couches, ottomans, dressers, chests, desks, stools, mirrors, tables, armoires, wardrobes, settees and vanity tables), overlap with registrant's "furniture" as identified in the cited registration, and must be deemed to be legally identical.

As to the respective marks, applicant argues that there is no likelihood of confusion herein because of the differences in the marks. Registrant's cited mark is BETSY CAMERON'S STORYBOOK, while applicant's mark is simply BETSY CAMERON. Although marks must be compared in their entireties, it is well established that there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). There is an undeniably close similarity between registrant's BETSY CAMERON'S STORYBOOK mark and applicant's BETSY CAMERON mark. Within registrant's mark, the words BETSY CAMERON (or BETSY CAMERON'S) have the greatest source-identifying

significance, and it is these words that will make the strongest impression on purchasers. Accordingly, we find that the dominant portion of registrant's mark is identical to the entirety of applicant's mark.

Applicant points out that registrant's mark consists of three words while applicant's mark is two words. Because we must view the respective marks in their entireties, we have considered the presence of the extra word STORYBOOK in registrant's mark. However, the presence or absence of the word STORYBOOK is not sufficient to distinguish the marks. The marks still look and sound very similar, have similar meanings, and convey the same overall commercial impression. People familiar with registrant's BETSY CAMERON'S STORYBOOK line of furniture will view BETSY CAMERON home furnishings as an additional line coming from the same source. Accordingly, we have no doubt that these similar marks, applied to identical goods, would result in a likelihood of confusion.

In determining likelihood of confusion under Section 2(d) of the Lanham Act, a critical du Pont factor to be considered is the market interface between applicant and the owner of a prior mark. In reviewing the prosecution history of this file and the emphasis in applicant's brief, we observe that applicant spends most of her time arguing

that this application should proceed to registration because registrant's use of the cited mark is pursuant to a license from applicant. Applicant argues in her brief as follows:

... the License Agreement clearly provides that Applicant is the owner of all rights in the name BETSY CAMERON and that Lexington's use of the name, along (sic) or in conjunction with other words, is pursuant to a license only. Applicant should be entitled to register her own name for furniture notwithstanding (sic) Lexington's registration of the name BETSY CAMERON'S STORYBOOK.

Hence, the document submitted by applicant entitled "DESIGN AND LICENSE AGREEMENT," (1996) and the related addendum (1997), are the primary focus of both briefs herein. Accordingly, we turn to a detailed examination of the relevant provisions of the license⁴ and addendum:

5.01 LEXINGTON [registrant] and DESIGNER [applicant] contemplate marketing of Home Furnishing Products by LEXINGTON under the LEXINGTON trademark and using the Tradename (sic) and Trademark "BETSY CAMERON." DESIGNER warrants that it has the right to grant, and DESIGNER hereby grants to LEXINGTON the right and license to use the Tradename (sic) and Trademark "BETSY CAMERON" on and in connection with the manufacture, advertising, distribution and sale of Home Furnishing Products and DESIGNER agrees that the right and license granted to LEXINGTON to use the Tradename (sic) and Trademark shall be exclusive as to the Products for so long as LEXINGTON markets Home Furnishing Products under this Agreement and is

⁴ According to page 17 (presumably the final page) of the license, registrant executed this contract on July 15, 1996, while applicant later executed it on September 9, 1996. By its terms (page 1 of the license), this contract modifies an earlier "Design Agreement" executed by applicant and registrant on October 20, 1994.

not in default for material breach of the terms of this Agreement. DESIGNER, her agents, successors or assigns agrees not to use, or to grant to any third party the right to use, the Tradename (sic) and Trademark in connection with the marketing or promotion of any furniture.

...
6.02 Subject to the royalty provisions of Article II, after December 31, 1996, LEXINGTON, at its sole discretion, may terminate the continuing work of DESIGNER in the Design Program of this Agreement for any reason, including convenience, and at any time, upon three (3) months notice to DESIGNER and DESIGNER thereupon shall be released from all outstanding obligations to continue design work for ...⁵

(license of 1996, pp. 10, 11 & 12).

The following addendum, apparently signed by applicant on December 11, 1997, also contains contract terms that are arguably relevant to the instant case:

1. LEXINGTON and DESIGNER have designed and developed a collection of Home Furnishing Products which LEXINGTON will market under the trademark BETSY CAMERON['S] (sic) STORYBOOK pursuant to the Design and License Agreement as supplemented herein.

...
3. All other covenants and agreements contained in the Design and License Agreement [the license of 1996] shall continue in full force and effect.

In her brief, the Trademark Examining Attorney summarizes her position as follows:

... Applicant submitted a document entitled "DESIGN AND LICENSE AGREEMENT" [hereinafter referred to as

⁵ Article 6.02 of the 1996 license continues at this point onto page 13 of the agreement, but that page is not included in this record. Based upon those limited portions of the license agreement made of record herein, it does not appear there is a set term for this contract, and while registrant may terminate the contract at its convenience with three months notice, applicant can only terminate upon registrant's material breach.

"License"] and an associated document entitled "ADDENDUM TO THE DESIGN AND LICENSE AGREEMENT" [hereinafter referred to as "Addendum"] with its April 14, 2000 response. ... [E]ven if both the License and the Addendum were in full force and effect, these agreements do not constitute a consent by the Registrant to the Applicant's use and registration of the mark. Moreover, the Applicant may not collaterally attack an existing and valid federal trademark registration during *ex parte* prosecution by showing evidence of a license agreement.

(Examining Attorney's appeal brief, unnumbered pp. 6 & 7).

While applicant does not, in her brief, expressly allege that these agreements amount to a consent agreement, it appears from this record to be the gravamen of applicant's argument. In any case, we agree with the position of the Trademark Examining Attorney that however one may characterize the market interface between applicant and registrant, we are not faced herein with a consent agreement designed to reduce confusion.

According to a careful reading of the license and addendum, applicant has licensed her professional name to the registrant to be used for home furnishings, and Article 5.01 of the license specifically precludes applicant from using her own name for these home furnishings (*viz.* "DESIGNER ... agrees not to use ... [her trade name] and

Trademark in connection with the marketing or promotion of any furniture.").⁶

Thus, this agreement cannot be construed as a consent by registrant. Instead, these documents demonstrate that applicant explicitly relinquished her right to use the name BETSY CAMERON in connection with furniture. As to applicant's right to *register*, the record contains nothing to suggest that applicant retained the right to *register* the mark BETSY CAMERON for furniture. In fact, Lexington's valid and subsisting registration stands as a testament to the opposite conclusion. Accordingly, we agree with the Trademark Examining Attorney that this license and addendum are of no avail to applicant in overcoming the Section 2(d) refusal at issue herein.

Moreover, to the extent that applicant may be trying to call into question the validity of the cited registration by the fact that she has licensed the use of her name to the registrant, this would be an impermissible collateral attack and we reject entirely this line of argument in considering likelihood of confusion herein.

Decision: The refusal to register is affirmed.

⁶ We note that the issue of fraud, based upon applicant's declaration in her application that she is "entitled to use the mark in commerce" on the home furnishing products identified in the application, was not raised by the Trademark Examining Attorney, and is therefore not before us in this appeal.